UNITED STATES PATENT AND TRADEMARK OFFICE

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10/678,646	10/06/2003	Timothy L. Robinson	134779.10101	7815

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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _06 October 2003_.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _33-60 and 66-69_ is/are pending in the application.
   4a) Of the above claim(s) _1-32 and 61-65_ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) _33-60 and 66-69_ is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on _06 October 2003_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.
   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
      Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
      Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Status of Claims

This communication is in response to application No. 10/678,646, filed on 10/06/2003.

Claims 33-60 and 66-69 are still pending as follow. The Examiner noticed that the set of

claims presented on 04/09/2010 made reference to application 11/304,786 in the

header section. Correction is required.

Election/Restrictions

1.   Applicant's election with traverse of 33-60 and 66-69 in the reply filed on

04/09/2010 is acknowledged.

2.   Claims 1-32, and 61-65 are withdrawn from further consideration pursuant to 37

CFR 1.142(b) as being drawn to collecting and storing information, removing hindrances

and encouraging enrollment in a biometric system. Election was made with traverse in the

reply filed on 04/09/2010.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

Claims **33-60 and 66** are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. The invention lacks a clear and precise definition of

"enabling portion" and "portion of the total enrollment" (MPEP § 2173.02).

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the
> conditions and requirements of this title.

5. Claims 33-66 and 66-69 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.

As to claims 33, 66 and 68, are method claims and as such must pass the

"machine or transformation test". In accordance with the M-or-T test, the claimed

process must: (1) be tied to a particular machine or apparatus (machine implemented);

or (2) particularly transform a particular article to a different state or thing. A method

claim that does not require machine implementation or does not cause a transformation

will fail the test and should be rejected under § 101. However, the mere presence of a

machine tie or transformation is not sufficient to pass the test. When a machine tie or

transformation has been identified, it must be further determined that the tie is to a

particular machine or the particular transformation is of a particular article. Additionally,

the particular machine tie or particular transformation must meet two corollaries to pass

the test for subject matter eligibility. First, the use of the particular machine or

transformation of the particular article must impose a meaningful limit on the claim's

scope. So, a machine tie in only a field-of-use limitation would not be sufficient. Second,

the use of the particular machine or the transformation of the particular article must

involve more than insignificant "extra-solution" activity. If the machine or transformation

is only present in a field-of-use limitation or in a step that is only insignificant "extra-

solution" activity, the claim fails the M-or-T test, despite the presence of a machine or a

transformation in the claim. In the instant application the applicant is not applying any

machine to the steps "…receiving …sending…storing …etc".

As to claims 34-60 and 66-69, they depend from claims **33, 66 and 68,** and do

not cure the deficiencies set forth above. Therefore, claims **34-60 and 66-69** are also

rejected for failing to include a sufficient tie to a particular machine or transformation.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

7.   **Claims 33-34, 40-53, and 54-60 are rejected under 35 U.S.C. 103(a) as**

being unpatentable over US Patent No. 6,256,737 (Bianco et al) in view of US. Pg.

Pub No. 2003/0130954 (Carr).

As to claim 33, Bianco discloses a method for enabling a user with a partial

enrollment record stored in a system database in a biometric system to use the

biometric system (abstract, Fig. 6), comprising:

receiving, at an enrollment enabling station, a portion of the total enrollment data

previously stored in a system user record (Col. 2: 53-67 and Col. 3:1-17);

receiving, at the enrollment enabling station, an enabling portion of the total

enrollment data not stored in the system user record during a previous system access

(Col. 9:32-59);

sending said portions of the total enrollment data to said system database

(Bianco discloses, "...The reports may include a list of different types of data

stored in biometric server 104 (e.g., a list of the currently enrolled users in

biometric system 102). In addition, administration station 108 is typically used to

setup the initial data in biometric server 104...", Col. 10:14-27);

storing, in said system database, the enabling portion of the total enrollment data

-in the system user record (Col. 16:36-44 and Col. 23:17-29);

But, Bianco does not disclose identifying the system user record as active.

However, Carr discloses a system that when establishes a record, sets a flag

indicator to "active" value (¶ 0044).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to incorporate Carr's teaching into the system of Bianco. One would be motivated to render data that reflects the status of user's record, in order to reflect a robust biometric system.

As to claim 34, Bianco and Carr disclose the method of claim 33, and further Bianco discloses comprising:

receiving identifying information for a user (Col. 2:53-67, Col. 3: 1-5); and

comparing between the identifying information and the total enrollment data for the system user record

(Bianco discloses the amount of data , one or more biometric templates, that during the execution of the biometric police is required to establish a user record, "…The collections of data include biometric templates, biometric policies, biometric groups, biometric device IDs, user IDs, computer IDs and application IDs. In the present invention, the biometric policies determine the way or method in which a user is to be authenticated by the system…The execution of the biometric policies involves the use of one or more biometric templates…", Col. 2:53-67, Col. 3: 1-5);

But, Bianco does not disclose activating the user record.

However, Carr discloses a system that when establishes a record, sets a flag indicator to "active" value (¶ 0044).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to incorporate Carr's teaching into the system of Bianco in order to reflect compliance with biometric policies.

As to claims 40 and 41, Bianco and Carr disclose the method of claim 33, and further Bianco discloses wherein the enrollment enabling station includes a record output device for outputting one or more system access records and, wherein each of the records are is configured as one or more of a printed report, a media output to an electronic device and an email (Col. 10:14-48).

Further, Bianco discloses the user is asked to give biometric measurements a few different times (Col. 27:1-2 and Col. 28:1-12). The Examiner notes that it is inherent that if Bianco's solution comprises a database system, it has a timestamp feature in place to store the date and the time and the identification of each transaction that access the database records.

As to claim 42, Bianco and Carr disclose the method of claim 33, and further Bianco discloses

displaying, at the enrollment enabling station, one or more portions of system user enrollment data stored at said system database (in Bianco's system the user is requested to provide multiple fingerprint measurements, Col. 27:1-2 and Col. 28:1-12); prompting the system user to confirm the displayed data (Bianco's solution has biometric policies, Col. 29:60-67 and Col. 30:1-3);

receiving confirmation of the displayed data from and storing, at said system

database, the confirmation (Col. 30:15-30).

As to claim 43, Bianco and Carr disclose the method of claim 42, and further

Bianco discloses further comprising enabling the user to present corrected data (The

threshold policy in Bianco's solution allows flexibility, correction, to the level of

protection to pass the authentication process, Col. 3:18-32, Fig. 31).

As to claims 44 and 54, Bianco and Carr disclose the method of claim 33, and

further Bianco discloses comprising receiving verification of one or more portions of the

total enrollment data from a system operator (Fig. 21A , 21B and Figs. 31).

As to claims 45 and 55, Bianco and Carr disclose the method of claims 44 and

54, and further Bianco discloses verifying portions of the total enrollment data (Bianco

discloses an enrollment station, Fig. 1, element 106).

But Bianco does not disclose offering said system operator one or more

incentives

 However, Carr discloses a mailing system that employs biometric data to identify

a sender and offers postage discounts (¶¶ 0044 and 0053)

Therefore, it would have been obvious to one of ordinary skill in the art, at the

time of the invention, to incorporate Carr's teaching into the system of Bianco. One

would be motivated to provide some stimulus via regular mail to gather user data.

As to claims 46 and 58, Bianco and Carr disclose the method of claims 44 and 54, and further Bianco discloses comprising comparing system operator data with data stored at said system database (Bianco discloses a biometric server, 104 and an enrollment station, 106. "…The types of data stored in biometric server 104 are partially determined through the operations of enrollment station 106 and administration station 108. Enrollment station 106 is used to enroll users into biometric system 102. Enrollment station 106 has attached to it every type of biometric device used by biometric system 102 to enroll and ultimately authenticate users…", Col. 10:1-27).

As to claims 47 and 59, Bianco and Carr disclose the method of claims 44 and 54, and further Bianco discloses wherein the system operator is remote from the enrollment enabling station (Fig. 2, Elements 106, enrollment station and element 208, user computer).

As to claim 48 and 57, Bianco and Carr disclose the method of claim 44 and 54, and further Bianco discloses wherein the verification includes a biometric sample received from the system user (Bianco teaches , "…First, a user is prompted for multiple samples of a fingerprint. For each sample, a number of characteristics or measurements are identified. Then, for all of the multiple samples, a number of common characteristics or measurements are identified…", Col. 8: 41-54).

As to claim 49, Bianco and Carr disclose the method of claim 44, and further Bianco discloses storing the verification in the system user record (Bianco teaches,

"... The device open interface is propriety software that is used to communicate to

biometric devices in order to retrieve live sample data, match live sample data against

stored data (i.e., biometric templates)...", Col. 14:9-19)

As to claim 50, Bianco and Carr disclose the method of claim 33, and further

Bianco discloses wherein the portion of the total enrollment data comprises one or more

biometric records (Bianco teaches, "...In FIG. 5, biometric server 104 (FIG. 1) stores

collections of biometric templates 502, biometric policies 504, biometric groups 506,

biometric device IDs 508, user IDs 510, computer IDs 512 and application IDs 514...",

Col. 17:38-48).

As to claim 51, Bianco and Carr disclose the method of claim 33, and further

Bianco discloses wherein said system database is located at the enrollment enabling

station (Col. 14:25-32).

As to claim 52, Bianco and Carr disclose the method of claim 33, and further

Bianco discloses comprising verifying, by one or more third parties or third party

databases, the data stored at said system database (Col. 56:1-27).

As to claim 53, Bianco and Carr disclose the method of claim 33, and further

Bianco discloses comprising sending an identification number to authenticate a sending

device (Bianco discloses "...biometric device IDs, user IDs", Col. 2:53-64).

As to claim 56, Bianco and Carr disclose the method of claim 54, and further

Bianco discloses further comprising identifying the system operator by comparing

system operator data with data stored at said system database (Bianco discloses,

"…The types of data stored in biometric server 104 are partially determined through the

operations of enrollment station 106 and administration station 108. Enrollment station

106 is used to enroll users into biometric system 102…", Col. 10:1-14.

Further, Bianco discloses, "…Here, biometric server 104 is performing as the

server and enrollment station 106 is performing as the client…", Col. 26:60-63).

As to claim 60, Bianco and Carr disclose the method of claim 33, and further

Bianco discloses wherein said system database includes a plurality of system

databases (Col. 16:64-66 and Col. 17:1-10).

8.   **Claims 35-38, and 39 are rejected under 35 U.S.C. 103(a) as being**

unpatentable over US Patent No. 6,256,737 (Bianco et al) in view of US. Pg. Pub No.

2003/0130954 (Carr) and in view of US Patent No. 7,630,986 (Herz at al).

As to claims 35-38, Bianco and Carr disclose the method of claim 33, but

Bianco does not disclose comprising:

        prompting a user to select at least one incentive from a plurality of incentives

wherein the plurality of incentives includes one or more of an item, a service, a gift

certificate, a coupon, a discount, and money.

rendering said at least one incentive by one or more of a direct rendering of said

incentive, a paper- based promise of said incentive and an electronic-based promise of

said incentive.

automatically dispensing said at least one incentive.

However, Herz discloses a user identifier used in biometrics via a credit card and

provide promotional offers and coupons. The incentive is provided in automatic way for

example at a kiosk using a biometric ID (Col 54:3-15 and Col. 151:29-39)

Therefore, it would have been obvious to one of ordinary skill in the art, at the

time of the invention, to incorporate Herz's teaching into the system of Bianco. One

would be motivated to provide stimulus to gather user data in order to build a reliable

and robust biometric database.

As to claim 39, Bianco, Carr and Herz disclose the method of claim 33, but

Bianco does not disclose further comprising sending said at least one incentive via a

parcel delivery network.

However, Carr discloses a mailing system that employs biometric data to identify

a sender and offers postage discounts (¶¶ 0044 and 0053)

Therefore, it would have been obvious to one of ordinary skill in the art, at the

time of the invention, to incorporate Carr's teaching into the system of Bianco. One

would be motivated to provide stimulus via regular mail to gather user data.

9.   **Claims 66-67 and 68-69 are rejected under 35 U.S.C. 103(a) as being**

unpatentable over US Patent No. 6,256,737 (Bianco et al) in view of US Patent No.

7,630,986 (Herz at al).

        As to claims 66 and 68, Bianco discloses a method for enrolling a user in a

biometric system (abstract, Fig. 6), comprising:

        storing at least a portion of a total enabling data that is in a database, said total

enabling data representing a minimum amount of data needed to enable a user to use

the biometric system (Col. 2: 53-67 and Col. 3:1-17);

        receiving an item of information that is associated with said user

        (Bianco's solution comprises a user ID, Fig. 6, element 614)

        retrieving said stored portion of the total enabling data based on said received

item of information

        (Bianco discloses, "...The reports may include a list of different types of data

        stored in biometric server 104 (e.g., a list of the currently enrolled users in

        biometric system 102). In addition, administration station 108 is typically used to

        setup the initial data in biometric server 104...", Col. 10:14-27);

        presenting at least part of said retrieved portion of the total enabling data to said

user for confirmation during an enrollment session (Bianco discloses, "...In the present

invention, the biometric policies determine the way or method in which a user is to be

authenticated by the system...", Col. 2:53-64)

        But, Bianco does not disclose data that is acquired from a third party.

However, Herz discloses, information the is stored in databases in third-party servers (Herz teaches, "…All three modes may use distributed information, i.e. it is possible that the information is stored in the central SDI database, or on distributed client-side information servers, or in third-party servers…", Col. 77:4-10)

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to incorporate Herz's teaching into the system of Bianco, in order to offer a robust and efficient system solution.

As to claims 67 and 69, Bianco disclose the method of claims 66 and 68, wherein said storing occurs prior to any enrollment sessions by said system user, and said presenting occurs during a first enrollment session by said user (Bianco's solution comprises a user ID that is assigned and stored before the enrolling process, Fig. 6, element 614).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. VICTORIA VANDERHORST whose telephone number is (571)270-3604. The examiner can normally be reached on regular business hours from Monday through Friday from 8:30 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynda Jasmin can be reached on 571 272 6782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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published applications may be obtained from either Private PAIR or Public PAIR.

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. V./
Examiner, Art Unit 3688
May 21, 2010

/Lynda Jasmin/
Supervisory Patent Examiner, Art Unit 3688